

U.S. Patent Application Serial No. 10/578,777
Amendment filed December 30, 2009
Reply to OA dated October 6, 2009

REMARKS

Claims 1-12 are pending in this application. Claim 4 is canceled herein without prejudice or disclaimer, and claim 1 is amended. Upon entry of this amendment, claims 1-3 and 5-12 will be pending. Entry of this amendment and reconsideration of the rejections are respectfully requested.

No new matter has been introduced by this Amendment. Support for the amendment to claim 1 is detailed below.

Claims 1-6 and 9-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ezawa et al. (U.S. Patent No. 4,966,805) in view of Komiya et al. (U.S. Patent No. 4,704,445). (Office action paragraph no. 2)

Claims 7 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ezawa et al. (U.S. Patent No. 4,966,805) in view of Komiya et al. (U.S. Patent No. 4,704,445) and further in view of Eckes et al. (U.S. Patent No. 4,812,492). (Office action paragraph no. 3)

Reconsideration of these rejections is respectfully requested in view of the amendment to claim 1. Support for the amendment to claim 1 may be found in canceled claim 4. A minor grammatical correction is also made to claim 1.

In arguing against the rejections, Applicant maintains the arguments made in the Response of August 7, 2009, in which Applicant argued that the claims require an adhesive between the shrink label and the vessel, and that there is no suggestion for this in Ezawa. Applicant also argued that the effects of the present invention are unexpected over the references.

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At page 3, lines 14-18, the Examiner acknowledges that Ezawa fails to disclose an adhesive coating film in contact with the PET bottle and between the heat-shrinkable film and the PET bottle.

The Examiner states:

“However, because the adhesive coating film adheres the label to the bottle, it would have been obvious for one of skill in the art to have provided for the coating film in any location between the label and the bottle, including in contact with the bottle.”

That is, the Examiner now argues that there is a general suggestion in the art to add an adhesive to Ezawa.

However, Applicant notes that the Office action at page 3, lines 4-13, is unchanged from the previous Office action, provides the motivation for having the adhesive in Ezawa meet the limitations of claim 1. However, this argument was directed to the existing adhesive in Ezawa, **which is between the heat-shrinkable polystyrene-base foamed sheet and the polystyrene-base film.** This is not the location of the adhesive in claim 1, and the qualities of an adhesive **between a heat-shrinkable polystyrene-base foamed sheet and a polystyrene-base film** would be expected to be different than those of an adhesive **between a heat-shrinkable film and a PET bottle**, as in claim 1. Therefore, the Examiner has **not provided a proper motivation** for achieving the limitations on the adhesive in claim 1.

The Examiner's argument is reiterated in the “Answer to Applicant's Arguments” in paragraph no. 4 of the Office action, and again, Applicant argues that this does not provide a proper motivation for the proposed modification.

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Applicant therefore argues against the rejection as follows:

1) The Examiner implies that there is a general suggestion or motivation in the art to add an adhesive to Ezawa between the heat-shrinkable polystyrene-base foamed sheet and the bottle. However, it is clear that Ezawa's sheet is "adhered closely to the vessel by heating" (column 3, lines 18-20), and is designed to adhere to the bottle based on its shrinkability (see column 3, lines 20-29). This is apparently a method that is generally carried out by heat-shrinking, and **without adhesive**. Therefore, there is no suggestion in Ezawa for adhesive between the bottle and the foamed sheet. Applicant also submits that there is no motivation in the general art to add an adhesive to a method based on heat-shrinking without adhesive.

2) As noted above, the Examiner's arguments regarding the limitations on the adhesive in claim 1 are based on modifying Ezawa's adhesive, which is between the two layers of Ezawa's composite sheet. Since Ezawa's adhesive is in a structurally different location and serves a different purpose from the adhesive in claim 1, the Examiner has not presented a proper motivation for this limitation, a further deficiency in the stated *prima facie* case of obviousness.

3) The Examiner has not responded to Applicant's "unexpected results" arguments presented in the Response dated August 7, 2009. (See page 8, lines 7-15, of that Response). Again, Applicant submits that advantageous effects of excellent removability, blocking resistance and PET bottle deformation are commensurate with the limitations of claim 1.

4) In addition, as noted above, claim 1 has been amended to incorporate the limitation of claim 4 that: "the heat-shrinkable film has a thickness of 10 to 100 μ m and a shrinkage stress of at

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least 2.0 N/cm in the main shrinkage direction." Both Ezawa and Komiya are completely silent with regard to such limitations, and Applicant submits that there is no suggestion or motivation in these references for these limitations.


Therefore the pending claims are not obvious over Ezawa '805, Komiya '445 and Eckes '492, taken separately or in combination.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicants' undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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